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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,462	09/15/2000	Terry Smith	2551-49	3620

7590 07/02/2002

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/662,462

Applicant(s)

SMITH ET AL.

Examiner

Jeanine A Goldberg

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 June 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 24-26 and 28-40.

Claim(s) withdrawn from consideration: 12-18.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

J. Goldberg


Continuation of 2. NOTE: The claims have been amended to require limitations which were not previously in the claims. For example, Claim 41 and dependant 43 have been amended to require, "wherein all said oligonucleotide sequences are functional under identical hybridization conditions". Moreover, this limitations causes the claim to become indefinite because it is unclear whether the claim is directed to a single oligonucleotide which has the same hybridization conditions as itself or whether the claim is intended to be directed to a composition comprising all of "said oligonucleotides" such that they hybridization conditions are identical. The method claims are minimally directed to hybridizing a single oligonucleotide. Therefore, it does not seem that the probe would not have the same hybridization conditions as itself.

Moreover, New Claim 53 has been added which increases the scope of the claims to matter which was originally restricted and not searched. SEQ ID NO: 14-32 and 39-43 has not been considered nor searched.

Newly added Claim 54 has been amended to require "under the same hybridization conditions" for hybridizing at least two of the oligonucleotides of Claim 41. This limitation was not previously required by the claims.

Continuation of 5. does NOT place the application in condition for allowance because: The arguments are directed the the newly amended claims which have not been entered. .

Continuation of 10. Other: Applicant's request clarification for the first time with respect to the Williams-1 and -2 references. Williams-1 has been used to refer to the first listed Williams reference, namely J. Clinc. Path. Vol. 49, No. 1, pages M23-M28. Williams-2 refers to the Genbank accession Number L47108. Moreover, Applicant's request clarification with respect to the "Lott et al" vs "Lott". This appears to be a typographical error which should read only "Lott" the US 6,242,178 patent. The rejection is Lott (US 6,242,178) in view of Hogan).


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600